

REMARKS

Applicants appreciate the faxing of the November 15, 2004 Official Action to the Attorney for Applicants on March 3, 2005. As noted during the telephone conference with the Examiner that day, after the Action was received by Applicants' counsel, it was not filed properly such that the faxed copy is currently Applicants' only copy of the Action.

In the Official Action of November 15, 2004, the title was objected to as not being clearly indicative of the invention and claims 7 and 9 were objected to because of informalities on line 2 of both claims. Claims 1-10 were rejected under 35 U.S.C. 103 as being obvious over the Dietz patent. Although amendments have been made to remedy the objections to the title and to claims 7 and 9, the §103 rejection of claims 1-10 is respectfully traversed. In accordance with the requirements of 37 C.F.R. 1.111(b), the basis for traversing this rejection is set out below.

The §103 rejection of claims 1-10 is traversed because the Official Action of November 15, 2004 fails to make out a proper *prima facie* showing of the obviousness of the differences between Applicants' claimed invention and the cited reference. As stated in the second paragraph of MPEP §706.02(j), "[t]o establish a *prima facie* case of obviousness, three criteria must be met." First, the rejection must indicate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP §706.02(j). A review of the November 15, 2004 Action indicates that, because it fails to establish these three criteria for a proper *prima facie* showing of the obviousness of the differences between the invention claimed in claims 1-10 and the cited prior art reference asserted in the Action, the §103 rejection is improper. Further, that rejection was improper even before Applicants amended the claims as set out above. Rather than amending the claims for the purpose of overcoming the §103 rejection, and as noted above, Applicants amended claims 7 and 9 in response to the objection set out in the Action. In addition, claims 1, 4, 7, 8, and 9 were amended to improve their form and/or to correct typographical errors.

Referring first to claim 1, the lack of a *prima facie* showing of the obviousness of the differences between claim 1 and the cited prior art reference is apparent by reference to the paragraph in the middle of page 3 of the Action stating that "Dietz does not teach [that] translation is done without first converting said information into a textual format" (the second paragraph of claim 1 as amended recites "means for converting information from said information receiving means directly from a primary language to a secondary language without first converting into a textual format"). To fill this "gap" in the teachings of Dietz, it is alleged in

the next paragraph of the Action that “[A]pplicant’s admitted prior art teaches an information converting means using any of several known software applications for converting speech to speech,” referring to page 11, lines 14-16 of the specification of the captioned application. However, at page 11, lines 14-16 of the specification, Applicants admitted only that commercially available software was available for converting (quoting from lines 16-17 of page 11 of the specification) “speech to speech (STS), speech to text (STT), text to text (TTT), and text to speech (TTS).” Applicants did not admit that software is available commercially for converting a primary language to a secondary language without first converting to text as recited in claim 1. Indeed, if Applicants **had** admitted that the commercially available software converted a first language to a second language without converting to text, that admission would have been inaccurate because, so far as is known, none of the commercially available software listed on page 11 actually does convert from a first language to a second language without first converting to text. In support of Applicants’ understanding of the manner in which these prior applications function, reference is made to column 1, lines 66-67, of Dietz, which references one of the same applications listed in Applicants’ specification, namely, the DRAGON™ software, and characterizes that software as an example “of the implementation of voice recognition and **speech to text** technology [emphasis added].” If the Examiner has personal experience of the manner in which these software applications function such that Applicants are incorrect in asserting that these commercially available applications convert speech to speech without converting to text, Applicants call upon the Examiner to make evidence of record (in the form of an affidavit as required by MPEP §2144.03) that such prior art is within the Examiner’s personal experience. In the absence of any such evidence, it is clear that the Action fails to establish this first required element of a proper *prima facie* obviousness rejection.

It is apparent just from this showing that the cited art fails to teach all the elements of the claimed invention that the Action fails to make out a proper *prima facie* obviousness rejection by MPEP §706.02(j). However, for purposes of completeness, Applicants also note that the Action fails to establish that the prior art provides a suggestion or motivation to modify the cited reference in the manner claimed. The closest the Action seems to come to identifying the required suggestion or motivation to modify the references in the manner claimed is set out in the penultimate paragraph on page 3 of the Action, which states that “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine that audible input and converting means of Dietz with the software application for converting speech to speech of the prior art **to increase the efficiency and speed** of the translation process [emphasis added].” It is respectfully submitted that this allegation of a motivation for making the claimed

be motivated to make the claimed combination by the increase in speed and efficiency is, in effect, generic, and could be used as a basis for asserting that almost all inventions are obvious. It may, for instance, be well known that one should increase the efficiency and speed of the drive system if they want to have enough fuel and arrive quickly enough to enable them to travel to solar systems other than the sun, but that motivation would not render obvious a drive system that propels a spacecraft at speeds faster than light. For all the guidance provided by this “generic” assertion of a motivation to make the claimed combination, the Action might as well have asserted that the modification was within the skill of one of ordinary skill in the art, and as stated at MPEP §2143.01,

“[a] statement that modifications of the prior to meet the claimed invention would have been ‘well within the ordinary skill of the art’ . . . because the references . . . teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references [citation omitted, underlining in original, bold emphasis added].”

It is therefore respectfully submitted that this “generic” assertion of the motivation to combine Dietz with the allegedly admitted prior art does not rise to the level of the showing required for a proper *prima facie* obviousness rejection.

Not only does the Official Action of November 15, 2005 fail to establish this second required element of a proper *prima facie* showing of obviousness, but it is respectfully submitted that it is most unlikely that such a showing can be made. Dietz specifically states (at column 1, lines 47-49) that “all speech communication must first be converted to text before it can be translated.” Nor is this quotation being taken out of context by Applicants – both the summary of the invention (specifically, column 3, lines 6-10) and the claims (for example, column 7, lines 23-24 of claim 1) of Dietz recite that the “captured” human utterance is converted to text for translation. One of ordinary skill in the art would not be led by disclosure that teaches the exact opposite (conversion to text for translation) of Applicants’ claimed invention (translation without converting to text) to modify Dietz in contradiction of the specific teachings of Dietz to make the claimed invention. It is therefore submitted that it is not possible to find the requisite motivation or suggestion to combine Dietz and the allegedly admitted prior art in the manner asserted on page 3 of the Action.

Of course when there is no suggestion in the art to modify the references in the manner asserted, there can be no showing of the third required element of a *prima facie* obviousness rejection, namely, an expectation of success. Applicants can find no indication that an attempt to make such a showing was even made in the Action. Further, because Dietz specifically teaches away from the claimed combination, it is respectfully submitted that one skilled in the art would

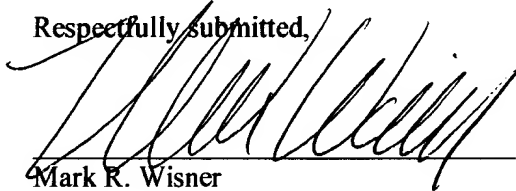
not expect that Dietz and the allegedly admitted prior art could be successfully combined, such that the requisite showing of an expectation of success is clearly lacking from the Action.

In the absence of a showing of (1) all the claimed elements in the cited art, (2) a suggestion in the art to modify the combined references in the manner claimed, and (3) some expectation that such modification(s) can be made successfully, the §103 rejection of claim 1 is improper. It is therefore respectfully requested that this rejection be reconsidered and withdrawn.

Because they are dependent on a nonobvious independent claim, claims 2-9 are also nonobvious and therefore allowable. In addition, new claims 11-14 have been added to more completely claim that which Applicants regard as their invention.

Reconsideration and withdrawal of the §103 rejection of claims 1-10, entry of new claims 11-14, entry of the above amendments to the claims, consideration of the remarks set out herein, allowance of the claims, and passage of the application to issuance are all respectfully requested. In the unforeseen event that there are questions and/or issues yet to be answered in this application, it is respectfully requested that Applicants' Attorney be contacted at the address and phone number set out below.

Respectfully submitted,



Mark R. Wisner
Registration No. 30,603
Wisner & Associates
1177 West Loop South, Suite 400
Houston, Texas 77027-9012
Telephone: (713) 785-0555
Facsimile: (713) 785-0561

ATTORNEY FOR APPLICANTS

Date: April 15, 2005